



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/098,545	03/18/2002	Takumi Takahashi	03500.016292	4950

5514 7590 04/20/2007
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

DURNFORD-GESZVAIN, DILLON

ART UNIT	PAPER NUMBER
----------	--------------

2622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/098,545	Applicant(s) TAKAHASHI, TAKUMI	
	Examiner Dillon Durnford-Geszvain	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12 and 14-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12 and 14-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/5/2007 has been entered.

Response to Amendment

2. Claims **1, 2, 3-12, 14-39** are pending, claims **1, 2, 4, 6, 8, 14, 16, 21, 22-25, 30, 32, 33** and **37** are amended and claims **3** and **13** have been cancelled..

Response to Arguments

3. Applicant's arguments with respect to claims **1, 2, 4-12** and **14-39** have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims **34-39** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim **34** recites the limitation "the number of images" in line 5. There is insufficient antecedent basis for this limitation in the claim. The Examiner will assume for the sake of a complete examination that this corresponds to the number of images stored in the image storage device.

The remaining independent claims contain a similar limitation and the dependent claims are indefinite as they depend from indefinite claims.

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims **1, 4, 6-8, 10, 12, 14, 16, 18-33** are rejected under 35 U.S.C. 102(e) as being anticipated by US Pre-Grant Publication 2002/0051181 (Nishimura).

As to claim **1**, Nishimura teaches a method for displaying on an image display device (304, for example, see Fig. 1) an image stored in an image storage device (315, for example) comprising: an information obtaining step of obtaining a display capability of the image display device (see [0061] and note that "the personal computer 315 verifies, with the aid of the supplementary information as necessary, the capabilities of the portable telephone set,") and the number of images stored in the image storage device (see [0049] and note that there are different procedures if a single image is sent or a moving image, i.e. multiple images, is sent); and a display determination step of determining whether an image is to be displayed or characters related to the image are to be displayed, in accordance with the display capability of the image display device

and the number of images stored in the image storage device (see [0049] and note that it is determined from the capability of the display device whether an image is to be displayed or a URL corresponding to the image is to be displayed).

As to claim 4, Nishimura teaches a method for displaying on an image display device (304, for example, see Fig. 1) an image stored in an image storage device (315, for example) comprising: an information obtaining step of obtaining a display capability of the image display device (see [0061] and note that "the personal computer 315 verifies, with the aid of the supplementary information as necessary, the capabilities of the portable telephone set,") and the number of images stored in the image storage device (see [0049] and note that there are different procedures if a single image is sent or a moving image, i.e. multiple images, is sent); and a display determination step of determining whether an image is to be displayed or the name of an image is to be displayed, in accordance with the display capability of the image display device and the number of images stored in the image storage device (see [0049] and note that it is determined from the capability of the display device whether an image is to be displayed or a URL, where the URL is essentially the name of the image, corresponding to the image is to be displayed).

As to claim 6, this claim is analogous to claim 1 except the applicant specifies that the image storage device determines if image data is to be transmitted or identification of the image data is to be transmitted (instead of displayed) in accordance

Art Unit: 2622

with the number of images stored in the storage device. As discussed above, if a moving image is to be sent, depending on the display capability of the image display device, only identification data (a URL) is sent.

As to claim 7, see the rejection of claim 6 and note that Nishimura further teaches a wireless transmission step of the image storage device transmitting, using wireless communication, the image data or characters related to the image data to the image reception device (see Fig. 1).

As to claim 8, this claim is analogous to claim 6 except the applicant specifies "identification of the image data" as "an image name." Note that, as discussed above, the Examiner believes that the URL discussed in Nishimura corresponds to an image name. Therefore, claim 8 is rejected on the same grounds as claim 6.

As to claim 10, this claim is analogous to claim 1 except it is drawn to a device that carries out the method of claim 1. Therefore, the same grounds for rejection can be made for claim 10 as for claim 1 except drawn to the device taught by Nishimura.

As to claim 12, this claim is analogous to claim 4 except it is drawn to device that carries out the method of claim 4. Therefore, the same grounds for rejection can be made for claim 12 as for claim 4 except drawn to the device taught by Nishimura

As to claim **14**, this claim is analogous to claim **10** except it is drawn to a program for the device of claim **10**. Since there must be a program for making the device of claim **10** perform the method of claim **1** the same argument and grounds for rejection can be made for claim **14** as for claims **1** and **10** except drawn to a program taught by Nishimura.

As to claim **16**, this claim is analogous to claim **12** except it is drawn to a program for the device of claim **12**. Since there must be a program for making the device of claim **12** perform the method of claim **4** the same argument and grounds for rejection can be made for claim **16** as for claims **4** and **12** except drawn to a program taught by Nishimura

As to claim **18**, this claim is similar to claim **12**, except it claims an image storage device instead of an image display device. As Nishimura teaches an image storage device 315, claim **18** is rejected on the same grounds as claim **12**.

As to claim **19**, this claim is similar to claim **18** except the applicant specifies "an image name" instead of "identification of the image data." Note that, as discussed above, the Examiner believes that the URL discussed in Nishimura corresponds to an image name. Therefore, claim **19** is rejected on the same grounds as claim **18**.

As to claim **20**, this claim is analogous to claim **19** except that is drawn to a

program instead of an apparatus. However, since the apparatus must have a program for carrying out the functions ascribed to it, the same argument can be used to reject claim **20** as was used to reject claim **19** except drawn to a program taught by Nishimura instead of a device.

As to claim **21**, this claim is analogous to claim **18** except drawn to a program instead for the apparatus of claim **18**. Therefore, the same argument can be made for the rejection of claim **21** as was made for the rejection of claim **18** except drawn to a program taught by Nishimura instead of a device.

As to claim **22**, see the rejection of claim **1** and note that Nishimura further teaches a method according to claim **1**, wherein said information obtaining step comprises a receiving step of receiving a list of images from the image storage device (note that this is inherent when attaching the image as is done in Nishimura), and includes determining the number of images based on the list of images (note that it determines from the name whether a moving image or a still image is to be attached, therefore obtaining the number of images from the list of names).

As to claim **23**, see the rejection of claim **1**, and note that Nishimura further teaches a method according to claim **1**, wherein said display determination step comprises a request step of requesting, from the image storage device, the image which it is determined to be displayed (note that this is inherent in the system of

Nishimura that uses email attachments and URLs).

As to claim **24**, this claim is analogous to claim **22** but depends from claim **4** instead of claim **1**. Therefore claim **24** is rejected on the same grounds as claim **22** but depending from claim **4**.

As to claim **25**, this claim is analogous to claim **23** but depends from claim **4** instead of claim **1**. Therefore claim **24** is rejected on the same grounds as claim **23** but depending from claim **4**.

As to claim **26**, see the rejection of claim **10** and note that this claim is analogous to claim **22** except it is drawn to a device that carries out the method of claim **22**. Therefore, the same grounds for rejection can be made for claim **26** as for claim **22** except drawn to the device taught by Nishimura.

As to claim **27**, see the rejection of claim **10** and note that this claim is analogous to claim **23** except it is drawn to a device that carries out the method of claim **23**. Therefore, the same grounds for rejection can be made for claim **27** as for claim **23** except drawn to the device taught by Nishimura.

As to claim **28**, see the rejection of claim **12** and note that this claim is analogous to claim **22** except it is drawn to a device that carries out the method of claim **22**.

Therefore, the same grounds for rejection can be made for claim **28** as for claim **22** except drawn to the device taught by Nishimura.

As to claim **29**, see the rejection of claim **12** and note that claim **29** is similar to claim **27** except the claim which it is dependent upon uses the name of an image to identify images instead of characters related to an image. Note that, as discussed above, the Examiner believes that the URL discussed in Nishimura corresponds to an image name.

As to claim **30**, see the rejection of claim **14** and note that claim **30** is a program that performs steps corresponding to the steps of claim **22** and is rejected using the same arguments as those used to reject claim **22** except drawn to the program of claim **14** as taught by Nishimura.

As to claim **31**, see the rejection of claim **14** and note that claim **31** is a program that performs steps corresponding to the steps of claim **23** and is rejected using the same arguments as those used to reject claim **23** except drawn to the program of claim **14** as taught by Nishimura.

As to claim **32**, see the rejection of claim **16** and note that claim **32** is a program that performs steps corresponding to the steps of claim **24** and is rejected using the same arguments as those used to reject claim **24** except drawn to the program of claim

16 as taught by Tanaka Nishimura.

As to claim **33**, see the rejection of claim **16** and note that claim **33** is a program that performs steps corresponding to the steps of claim **25** and is rejected using the same arguments as those used to reject claim **25** except drawn to the program of claim **16** as taught by Nishimura.

Claim Rejections - 35 USC § 103

8. Claims **2**, **11** and **15** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pre-Grant Publication 2002/0051181 (Nishimura) in view of US 6,313,877 (Anderson).

As to claim **2**, see the rejection of claim **1** and note that Nishimura does not teach a thumbnail image display step of displaying a plurality of thumbnail images; and a full image display step of displaying an image corresponding to one of the thumbnails.

However, Anderson teaches displaying a plurality of thumbnail images and displaying a full image corresponding to one of the displayed thumbnail images (see Fig. 5 and Column 4 lines 54-61).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the display style of Anderson in the image transfer system taught by Nishimura as, in a case where multiple images are sent and the display device is capable of displaying them, this would allow a user to see many small images and one larger image and would assist the user in readily confirming which

image they want to choose when they are choosing from the plurality of thumbnails.

Claim **11** is a device claim that corresponds to the method of claim **2** and is rejected on the same grounds as claim **2** except drawn to a device instead of a method.

Claim **15** is a program claim corresponding to the method of claim **2** and the device of claim **11** and is rejected on the same grounds as those two claims as drawn to a program instead of a device or method. Note that this program is necessary for the device of claim **11** to carry out the method of claim **2**.

9. Claims **5**, **9** and **17** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pre-Grant Publication 2002/0051181 (Nishimura).

As to claim **5**, see the rejection of claim **4** and note that Nishimura would have considered adding multiple attachments to the same email. Note also that if a movie file is attached and the device is incapable of displaying moving images it may display a still image corresponding to the moving image and a URL where that moving image can be found, as discussed above the Examiner is interpreting the URL to be the name of the image. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have attached multiple moving image files and displaying the names corresponding to these images and displaying one of the multiple images whose names are displayed.

As to claim **9**, see the rejection of claim **8** and note that, as discussed in the rejection of claim **5**, Nishimura would consider a display step of displaying multiple names that are transferred; and a transmission step of transmitting from the image storage device to the image reception device image data in accordance with one of the displayed multiple names (see the rejection of claim **5** above).

As to claim **17**, this claim is analogous to claim **5** except drawn to a program instead of a method. Therefore the same grounds for rejection can be made for claim **17** as for claim **5** except drawn to a program taught by Nishimura.

10. Claims **34-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pre-Grant Publication 2002/0051181 (Nishimura) in view of US Pre-Grant Publication 2001/0041056 (Tanaka et al.).

As to claim **34**, as discussed above in the rejection of claim **1** Nishimura teaches a method of transmitting images depending on the number of images and a display capability of a display device. What Nishimura does not teach is where the image reception device initiates the transfer. However, Tanaka et al. teaches a method of initiating the transfer of an image from an image reception device ([0089]). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed the image reception device to initiate the transfer of images as taught by Tanaka et al. as this would allow for a user to retrieve images from an image

Art Unit: 2622

storage device even if they were not able to physically access the image storage device.

As to claim **35**, see the rejection of claim **34** and note that as discussed above in the rejection of claim **1**, Nishimura teaches transferring image data or identification data depending on the number of images.

As to claim **36**, this claim is analogous to claim **34** except it is drawn to a device that carries out the method of claim **34**. Therefore, the same grounds for rejection can be made for claim **36** as for claim **34** except drawn to the device taught by Nishimura.

As to claim **37**, this claim is analogous to claim **35** except it is drawn to a device that carries out the method of claim **35**. Therefore, the same grounds for rejection can be made for claim **37** as for claim **35** except drawn to the device taught by Nishimura.

As to claim **38**, this claim is analogous to claim **36** except it is drawn to a program for the device of claim **36**. Since there must be a program for making the device of claim **36** perform the method of claim **34** the same argument and grounds for rejection can be made for claim **38** as for claims **34** and **36** except drawn to a program taught by Nishimura.

As to claim **39**, this claim is analogous to claim **37** except it is drawn to a program

Art Unit: 2622

for the device of claim 37. Since there must be a program for making the device of claim 37 perform the method of claim 35 the same argument and grounds for rejection can be made for claim 39 as for claims 35 and 37 except drawn to a program taught by Nishimura.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dillon Durnford-Geszvain whose telephone number is (571) 272-2829. The examiner can normally be reached on Monday through Friday 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ngoc-Yen Vu can be reached on (571) 272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

4/13/07


NGOC-YEN VU
SUPERVISORY PATENT EXAMINER